

Appl. No. 10/829,230
Reply to Office Action of October 19, 2006
Attorney Docket No. 26112

REMARKS/ARGUMENTS

Claims 1 – 7 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks. Claim 8 has been withdrawn without prejudice or disclaimer.

In the outstanding Office Action, the Examiner rejected claims 1 – 4, 6 and 7 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,025,286 to Kawatsu et al. (hereinafter referred to as “the Kawatsu et al. ‘286 patent”); and rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over the Kawatsu et al. et al. ‘286 patent.

By this Response and Amendment, the specification has been amended to more clearly disclose various advantages of the presently claimed invention; and the prior art rejections have been traversed. It is respectfully submitted that new matter under 35 U.S.C. §132 has been introduced to this application.

Rejections in View of The Kawatsu et al. ‘286 Patent

The Examiner rejected claims 1 – 4, 6, and 7 as being anticipated by the Kawatsu et al. ‘286 patent and rejected claim 5 as being obvious over the Kawatsu et al. ‘286 patent.

Response

By this Response and Amendment, Applicants respectfully traverse the rejections since all of the features of the presently claimed invention are not disclosed, taught or suggested by the cited prior art. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To establish a *prima facie* case of obviousness, the Examiner must show that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In*

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re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

(1) The thermoplastic resin of the porous resin layer (porous film) of the presently claimed invention has a melting point of 50 to 150°C (page 8, lines 5 to 16 and table 1 of the specification). In contrast, the films of Kawatsu have the melting points (Tm1) over 150°C, e.g., 192 C (Example 1), 198°C (Example 2), 190°C (Example 3), and 191°C (Example 4).

The melting point of the thermoplastic resin relates to the properties of G1/G2 of the claimed invention. G2 of the presently claimed invention is a storage modulus at 180°C in which the resin has been melted completely (page 8, lines 17 to 22 of the specification). From their melting points over 180°C, it is clear that the films of Kawatsu cannot possess the G1/G2 property.

Therefore, the assertion of the Examiner that the films of Kawatsu inherently possess the features of the claimed invention is completely wrong.

(2) The Examiner asserts that the polyester film of Kawatsu has inorganic particles and it is stretched; therefore, the film of Kawatsu may comprise pores.

In this technical field, such inorganic particles are contained in order to give sliding friction (column 5, lines 25 to 29 of Kawatsu). Also, please refer to, for example U.S. Patent 5,360,665 to Sato et al., column 2, lines 48 to 56 (The film of the present invention is provided with suitable slipperiness by roughening the surface thereof in order to improve windability in production, operability in laminating and printing and preventing adhesion of the film to the thermal head due to fusion of the film. Specifically, the surface of the film is suitably roughened by incorporation of 0.1-5.0 wt %, preferably, 0.1-3.0 wt % of fine particles having average particle size of 0.05-2.0 µm).

Therefore, the fact that the film of Kawatsu includes inorganic particles and is stretched does not provide any evidence of the porosity of the film, more specifically the porosity of the present

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invention that is formed preferably by the methods (1) to (4) in the specification, page 16, lines 11 to 30, and the assertion of the Examiner is wrong.

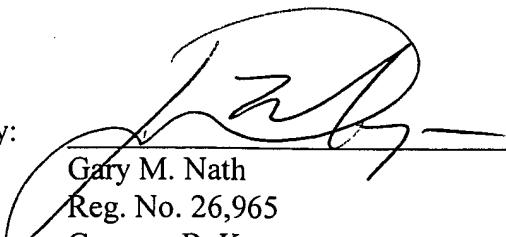
The Kawatsu et al. '286 patent does not disclose, teach or suggest all of the features of the presently claimed invention. Moreover, as claims 2 – 7 depend from claim 1, these claims necessarily contain all of the features of independent claim 1. Thus, dependent claims 2 – 7 are asserted to be allowable at least for similar reasons as independent claim 1. Therefore, Applicants respectfully request that the prior art rejections be reconsidered and withdrawn.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
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